



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/666,011

09/17/2003

Andrew West

50325-0813

6594

29989 7590 06/11/2007
HICKMAN PALERMO TRUONG & BECKER, LLP
2055 GATEWAY PLACE
SUITE 550
SAN JOSE, CA 95110

EXAMINER

ROBERTS, BRIAN S

ART UNIT

PAPER NUMBER

2616

MAIL DATE

DELIVERY MODE

06/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/666,011

Applicant(s)

WEST ET AL.

Examiner

Brian Roberts

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-22 is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

- Claims 1-22 have been examined.

Drawings

1. The drawings are objected to because the elements in Figures 1, and 5(a)-5(c) should be labeled to facilitate understanding of the drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 7-14 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 7 and 8 do not specify that the sequence of instructions are on a **computer readable medium**.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In reference to claim 6

In claim 6, line 2, the limitation "utilizes Internet Protocol (IP) as a transport layer protocol" renders the claim indefinite. Internet Protocol is associated with the network layer and not the transport layer.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-6 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Dunn et al. (US 6324280)

- In reference to claim 1 and 15

In Figure 1, Dunn et al. teaches a system that includes:

- A Protocol handler/vocoder **3** in an originating toll access switch (*first coding unit*) that is communicatively coupled to an originating station **25** (*first endpoint*) via a local PSTN **21** (*circuit-switching telephone network*) and communicatively coupled to the Internet **10** (*first packet-switching network*) for transmission of voice information that is associated with a voice call (column 2 lines 35-62)
- A processor **5** in an originating toll access switch (*first signaling unit*) that is communicatively coupled to the Protocol handler/vocoder **3** (*first coding unit*), and to a processor **5** in the terminating toll access switch (*second signaling unit*) via a CCS7 network **5** (*second packet-switching network*) for transmission of signaling information that is associated with set-up of a voice call (column 2 lines 35-62)
- A Protocol handler/vocoder **4** in the terminating toll access switch (*second coding unit*) communicatively coupled to a terminating station **26** (*second*

endpoint) and to the processor **5** in the terminating toll access switch (*second signaling unit*) (column 2 lines 35-62)

- Wherein the processor **5** in the originating toll access switch (*first signaling unit*) and the processor **5** in the terminating toll access switch (*second signaling unit*), over the CCS7 network **5** (*second packet-switching network*), signaling information that is associated with a particular voice call (column 3 line 34 – column 4 line 4)
- Wherein the Protocol handler/vocoder **3** in the originating toll access switch (*first coding unit*) and the Protocol handler/vocoder **4** in the terminating toll access switch (*second coding unit*) transmit, over the Internet **10** (*first packet-switching network*), voice information that is associated with the particular voice call. (column 3 line 34 – column 4 line 4)

- In reference to claim 2

In Figure 1, Dunn et al. further teaches the signaling information that is associated with set-up of a voice call is received in accordance with a first protocol and the signaling information that is transmitted over the CCS7 network **5** (*second packet-switching network*) is in accordance with a second protocol that is different than the first protocol. (column 3 line 34 – column 4 line 4)

- In reference to claim 3

In Figure 1, Dunn et al. further teaches the voice information that is transmitted over the Internet **10** (*first packet-switching network*) is in accordance with a third protocol that is different than the second protocol. (column 3 line 34 – column 4 line 4)

- In reference to claim 4

In Figure 1, Dunn et al. further teaches the circuit-switching network is a public-switched telephone network **21** and the first packet-switching network is the Internet **10**. (column 2 lines 35-62)

- In reference to claim 5

In Figure 1, Dunn et al. further teaches the first packet-switching network and the second packet-switching network are the same physical network. (column 2 lines 35-62)

- In reference to claim 6, as best understood

In Figure 1, Dunn et al. further teaches the signaling information that is transmitted over the second packet-switching network utilizes Internet Protocol (IP) as a network layer protocol. (column 3 line 34 – column 4 line 4)

Allowable Subject Matter

8. Claims 16-22 are allowed.

Art Unit: 2616

9. Claim 7-14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 set forth in this Office action.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are:

- Hluchyj (US 2002/0041591) teaches an apparatus and method for a telephony gateway.
- Kelly (US 6347085) teaches a method and apparatus for establishing communications between packet-switched and circuit-switched networks.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Roberts whose telephone number is (571) 272-3095. The examiner can normally be reached on M-F 10:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (571) 272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BSR
06/04/2007



HASSAN KIZOU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600